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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,315	12/13/2001	Michael Voticky	043829.0045	6087

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AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.  
300 WEST 6TH STREET  
SUITE 2100  
AUSTIN, TX 78701

EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

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DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/683,315

PRG  
Applicant(s)

VOTICKY ET AL.

Examin r

Robert B. Harrell

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-- Th MAILING DATE f this communication appears n the cover sheet with the corresp ndence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 13 December 2001 and 10 April 2002.

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-20 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 13 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☒ Other: *see attached Office Action*.

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1. Claims 1-20 are presented for examination. Claims must be numerical numbered and not alphanumeric.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims are more directed to Prioritizing Electronic Messages based on the Sender' Address.
3. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).
4. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non-statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).
5. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No 6,351,764. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons outlined below.
6. Although the wording between the claimed subject matter of

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this application and those of the Patented claim are not identical, the claimed subject matter of this application encompasses the scope of the Patented claims. For example, and not limiting either set of claims thereto, the additional limitations of the Patent's first claim (eg., the step of looking-up the unique identifier in a database and depositing the received information message into at least one of a plurality of virtual mailboxes) is absent from the first claim of this application. That is to say, the claims of this application are those of the Patented claims with limitations of the Patent claims stripped to form the claims of this application. Hence, the claims of this application are boarder in scope then those of the Patent claims and thus encompasses the scope of the Patented claims. A test for double patenting is to see if the application claims literally infringe on the Patent claims, as is in this case. As for the dependent claims, they each map correspondingly to each other between this application and the patent. The other claims of this application infringe those of the Patent claims as grouped below in a format of first the application claims to the left of the Patented claims:

a) 1 1;

b) 2 1;

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- c) 3 1;
- d) 4 3;
- e) 5 5;
- f) 6 4;
- g) 7 4;
- h) 8 4;
- i) 9 3;
- j) 10 6;
- k) 11 1;
- l) 12 7;
- m) 13 9;
- n) 14 11;
- o) 15 10;
- p) 16 10;
- q) 17 10;
- r) 18 9;
- s) 19 12;
- t) 20 13.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-20 are rejected under 35 U.S.C. 102 (b) as being

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clearly anticipated by Scannell et al. (5,377,354).

9. Per claim 1, Scannell taught a method of prioritizing and sorting (eg., see Title) a received information message (eg., see Title "Electronic Mail Messages" (known as email)), a source ("sender" line 32 of col. 5) of delivery of the received information message being indicated by a unique identifier (eg., see col. 5 (line 33 "unique binary identifier")) accompanying the received information message (eg., see col. 5 (lines 32-39)) comprising the steps of:

a) receiving (eg., see col. 2 (line 62) and col. 3 (line 34)

"received") the received information message (eg., see Abstract, col. 3 (lines 37-39));

b) assigning (eg., see col. 3 (line 2 "assigns")) a code (eg., see col. 3 (line 2 "code") and also priority level as shown in col. 6 (line 65-et seq.)) for the received information message based on the unique identifier ("sender filed" in col. 6 (lines 27-30)) accompanying the received information message (eg., see Title, Abstract, col. 2 (line 54) to col. 3 (line 11), and col. 6 (line 63-et seq.)); and,

c) prioritizing (eg., see col. 2 (line 66 "prioritizing")) the received information message (electronic mail message of col. 2 (line 66)) according to the code (eg., see Title, Abstract, col.

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2 (line 54) to col. 3 (line 11), and col. 6 (line 63-et seq.)).

10. Per claim 2, see figure 1 (15) for virtual mailboxes which were the different folders "FLDR". Also see the Abstract (line 16 "main folder")), col. 2 (line 8 and 3), col. 3 (lines 33-59), col. 4 (lines 38-43), and col. 7 (lines 1-4 (that is the "sender field" of col. 6 (line 27) is used to establish a priority (col. 6 (line 65)) rule which priority rule is used to determine which folder the electronic message should be stored per col. 7 (lines 1-4))).

11. Per claims 3 and 11, looking-up the unique identifier in a database (eg., see figure 2 (12)) was covered in col. 6 (line 9-et seq.).

12. Per claims 4-9, see Title "electronic mail" for e-mail see col. 3 (line 36-et seq.). As to fax and voicemail, it was well known to "attach" fax, digitized voice messages, and the like to/with/in the email. Per using the unique identifier, such has been addressed above as the "sender field" of col. 6 (line 27) which were known to be in nature, or have therein, alphanumeric (ie., SomeoneA1190@someplace.com) for emails or telephone numbers if phone based.

13. Per claim 10, one or more of the above cited method steps where performed by a client (work station), as shown in figure 1

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and covered starting with line 24 of col. 3, which had a message storage device (11). The claim recites "or" a combination; thus only one limitation need be shown (ie., message storage device). However, workstations implied and inherently contained a computer, or was a computer with storage.

14. Per claims 12-20, such claims parallel, and do not teach or defined, the above rejected claims and are thus rejected for the same reasons given above. However, claim 20 recites the invention on a computer readable medium. Scannell was shown to be a method (with apparatus) which required a computer readable medium to store the method thereon. Hence, such limitation of claim 20 was inherently required and anticipated by the Title which contained the word "Method".

15. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (703) 308-9705. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

  
**ROBERT B. HARRELL**  
**PRIMARY EXAMINER**